

JUL 06 2006

Application No. 10/654,508

Reply to Office Action

REMARKS

Reconsideration of referenced application is respectfully requested in view of the following remarks.

Summary of the Office Action

The Office Action rejects claims 1, 7 and 9 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 6,238,838 to Gaschler et al. ("the '838 patent").

It is asserted in the Office Action that the IR-compound in column 4 (Formula F5) is a cationic IR-absorbing dye that meets the limitations of claim 1. Moreover, Z¹ and Z² of the compounds of the '838 patent are said to preferably constitute isopropylidene groups (-C(CH₃)₂-) as in claim 7.

Claims 1-10 are also rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 6,492,093 to Gaschler et al. ("the '093 patent").

The '093 patent is asserted to disclose recording materials comprising a substrate and a mixture of a binder layer and positive-working IR-sensitive dye layer, the dyes used therein comprising cyanine dyes. Examples of suitable IR-sensitive dyes are those set forth in column 4 (Formula III), column 5 (Formula IV), and column 6 (Formulas F₁-F₄). The substituted groups of each formula meet the limitations of claim 1.

Discussion

In response to the rejection based on the '838 patent, Applicants submit that the IR-absorbing dyes of the '838 patent do not meet all the limitations set forth in the claims. In particular, and by way of example, the dyes disclosed and taught by the '838 patent do not include groups G¹ or G² as required by the pending claims, e.g., wherein the solubilizing groups G¹ and G² are anionic or become anionic in an aqueous alkaline solution having a pH of at least 9 and wherein the total number of the solubilizing groups G¹ and G² is equal to three, four or five.

Application No. 10/654,508

Reply to Office Action

Unless it can be demonstrated that the '838 patent discloses or teaches each and every limitation of the claims, an anticipation (or obviousness) rejection cannot be sustained. Here, because at least the limitations relating to the G^1 and G^2 solubilizing groups are not disclosed in or taught by the '838 patent, it is respectfully requested that the rejection be withdrawn.

Turning to the rejection of claims 1-10 based on the '093 patent, it is also the case that this patent does not disclose or teach the claimed invention. For example, the dyes identified in the '093 patent (Formulas III, IV, F_1 , F_2 and F_3) do not contain the R^3 group as required by claim 1. The group in the meso-position of the '093 patent dyes, which is argued in the Office Action to correspond to the R^3 group of claim 1, is a derivative of barbituric acid and, thus, is not an aryl group.

An aryl group may be described as a univalent aromatic radical (e.g., phenyl) derived from an arene by removal of one hydrogen atom from a carbon atom of the nucleus, while an arene may be described as an aromatic hydrocarbon (e.g., benzene, toluene). The derivative of barbituric acid group in the '093 patent dyes is not a radical derived from an aromatic hydrocarbon and, consequently, is not an aryl group. The facts simply do not support a rejection on this basis. Moreover, the dye of Formula F_4 does not contain the solubilizing groups G^1 or G^2 as defined in claim 1.

For the foregoing reasons, Applicants submit that there is no disclosure or teaching in the '093 patent of the inventive subject matter of claims 1-10. It is therefore respectfully requested that the rejection of these claims over the '093 patent be withdrawn.

Conclusion

As Applicants believe the application is in proper condition for allowance, the examiner is respectfully requested to pass the application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Application No. 10/654,508

Reply to Office Action

Respectfully submitted,

Christopher T. Griffith, Reg. No. 33,392
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: July 6, 2006